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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/249,489	02/12/1999	TETSUJIRO KONDO	80398.P198	9991

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EXAMINER

CHAUDRY, M. MUJTABA K

ART UNIT

PAPER NUMBER

2133

DATE MAILED: 12/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/249,489

Applicant(s)

KONDO ET AL.

Examiner

Mujtaba K Chaudry

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-96 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-96 is/are rejected.
- 7) ☒ Claim(s) 1, 44-45 and 77 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statements filed on *April 13, 2000, August 7, 2000* and *September 05, 2000* fail to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. The missing information referred to therein has not been considered.

Drawings

2. The drawings are objected to because:
 - In Figure 1c "IN" should be replaced with "data in" or "data." Similar should be done with "OUT."
 - In Figure 2, reference numbers 220 and 225 are not explained in the specification.
 - In Figure 4, reference number 420 is not mentioned in the specification.
 - In Figure 6, the scaling for the axis is not shown.
 - In Figure 7, the scaling for the score distribution axis is not shown.
 - In Figure 9, reference numbers 910, 915 and 930 are not mentioned in the specification.
 - In the specification there is reference to a Figure 12 which has not been submitted by the applicant.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities:
 - On page 5, in the brief descriptions for the drawings, the applicant needs to rewrite descriptions for Figures 1a-c such that they are at least somewhat informative.
 - On page 6, line 13 the description for Figure 12 has not been considered since there is no Figure 12 included in the drawings. Applicant is requested to either submit a drawing or eliminate information regarding Figure 12 from the application.
 - On page 9, line 11 there is unnecessary blank space that should be omitted.
 - On page 12, line 14 the term "G()" is improper and should perhaps be replaced with "G."
 - On page 13, lines 22 and 26 the reference number 520 is not shown in the drawings.
 - On page 22, line 7 the US patent application number should be filled in.
 - On pages 22-23, the description for Figure 12 is not considered since there is no Figure 12 included in the drawings.

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- A substitute specification without the claims is required pursuant to 37 CFR 1.125(a) because the specification is replete with 112 second paragraph problems.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

- The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Appropriate correction is required.

Claim Objections

4. The examiner would like to point out that Claim 77 is missing. In accordance with 37 CFR 1.126 the claims must not be renumbered.
5. Claim 1 is objected to because of the following informalities:
 - In line 3 of the claim the term “of decoding” should perhaps be eliminated.

Appropriate correction is required.

6. Claims 44 and 45 are objected to because of the following informalities:

- Claims 44 and 45 are shown to be dependent on claims 2 and 1 respectively.

Perhaps they should be dependent on claims 42 and 41 respectively.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 cites the limitation “candidate hypotheses” and “hypotheses” which are not clearly defined in the specification. For example, applicant states (page 7, lines 24-25) “...hypotheses, referred to herein as candidate hypotheses...” Hence, the term “hypotheses” used after this citation may only mean the normal definition: *hypothesis* - tentative explanation that accounts for a set of facts and can be tested by further investigation. The applicant further uses the term “hypothesis” numerous times thereafter (page 7 - line 27, page 8 - line 2 etc.). It is not clear on when the applicant is referring to “candidate hypotheses” and when to generic definition of “hypothesis” is implied. An example of this may be found on page 7, line 26-27 where the applicant attempts to define the term “score” (*a score is a generated with respect to each hypothesis and the hypothesis with*

the best score is selected as the recovered values). The examiner would like to point out that the specification is replete with this problem.

In another instance the applicant (page 8, lines 6-7) uses the phrase "*candidate hypotheses results*" without due explanation. On page 8, lines 6-7 the applicant states "...error propagation detection circuit evaluates *candidate hypotheses* to generate *candidate hypotheses results* ..." which is not clear. Even in the literal meaning of the terms the statement is implying to '*generate candidate possible results results from candidate possible results,*' if the term "*hypotheses*" is defined as "*possible results.*" The applicant states (page 7, lines 24-26) "*the Qbit and Motion Flag recovery circuit 10 generates hypotheses, referred to herein as candidate hypotheses, of possible number of quantization bits (Qbit) used and motion flag values.*" The examiner would like to point out that this does not define what "candidate hypotheses" is. Furthermore, applicant states (page 9, lines 6-9) "*The decoder 70 decodes those portions of the bit stream that are decodable using standard available decoding processes, i.e. portions containing no errors. Candidate decoder 72 generates candidate decodings and selects a best candidate decoding.*" Here the applicant uses the term "*Candidate decodings*" which is not defined. Also, if it assumed that "candidate decodings" and "candidate hypotheses" are interchangeable then the term "candidate hypotheses" can be deductively interpreted. Since the input data comprises of data and error information, and the decoder 70 decodes the data with no errors, it can be concluded that the candidate decodings are the portions with errors. This is not clearly defined and furthermore needs to be address throughout the claims and specification.

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Claims 16, 30, 40, 41, 52, 63, 71, 72, 81, 89, and 96 cite similar language as in claim 1.

Claims 2-15, 17-29, 31-39, 42-51, 53-62, 64-70, 73-80, 82-88 and 90-95 depend from claims 16, 30, 40, 41, 52, 63, 71, 72, 81, 89, and 96, hence inherit the deficiencies of claims 16, 30, 40, 41, 52, 63, 71, 72, 81, 89, and 96.

Conclusion

Applicant is requested to revisit the disclosure and provide a new specification written concisely without entering new matter. The examiner would like to point out that the specification is replete with 35 USC § 112 errors and needs to be addressed thoroughly before a subsequent action. Furthermore, while applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The examiner would like to point out that the claims could not be examined under prior art due to severe 35 USC § 112 problems that would not enable one of ordinary skill in the art to interpret what the applicant has stated.

Any inquiries concerning this communication should be directed to the examiner, Mujtaba Chaudry who may be reached at 703-305-7755. The examiner may normally be reached Mon – Thur 7:30 am to 4:30 pm and every other Fri 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, please contact the examiner's supervisor, Albert DeCady at 703-305-9595. The fax phone number for the organization where this application is assigned is 703-746-7239.

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Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the receptionist at 703-305-3900.



Mujtaba Chaudry

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November 19, 2002



ALBERT DECADY
SUPERVISORY PATENT EXAMINER
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